



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,857	09/28/2001	John S. Hendricks	3960.D19	3260

38598 7590 07/07/2004

ANDREWS KURTH L.L.P.  
1701 PENNSYLVANIA AVENUE, N.W. SUITE 300  
WASHINGTON, DC 20006

EXAMINER
----------

WINTER, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/964,857

**Applicant(s)**

HENDRICKS, JOHN S.

**Examiner**

John M Winter

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 10-29 have been examined

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10- 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al., (US Patent No 5,532,920) in view of Ross (US Patent No 5,465,213).

As per claim 1,  
Hartrick et al. ('920) discloses a method for storing text for electronic books to be displayed on a viewer, comprising:  
displaying an indication of a plurality of electronic books on a viewer;(Figure 11)  
selectively displaying pages for the selected electronic book;(Figure 3C)  
downloading text material for the selected electronic book from a portable storage medium.(Column 4, lines 45-52)

Hartrick et al. ('920) does not explicitly disclose receiving a request to view one of the electronic books. Ross ('213) discloses receiving a request to view one of the electronic books. (Figure 2) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Hartrick et al. ('920) method with the Ross ('213) method in order to promote the usage of digital media.

Claim 20 is in parallel with claim 10 and rejected for at least the same reasons.

As per claim 11,  
Hartrick et al. ('920) discloses the method of claim 10  
wherein the downloading step includes downloading the text material from at least one of the following: a smart card; an electronic memory card; and a PCMCIA card.(Column 4, lines 45-52)

Claim 21 is in parallel with claim 11 and rejected for at least the same reasons.

As per claim 12,  
Hartrick et al. ('920) discloses the method of claim 10  
further including associating a unique key with the text material.(Column 14, lines 15-26)

Art Unit: 3621

Claim 22 is in parallel with claim 12 and rejected for at least the same reasons.

As per claim 13,  
Hartrick et al. ('920) discloses the method of claim 12  
wherein the downloading step includes selectively downloading the text material based  
upon the unique key.(Column 14, lines 27-38)

Claim 23 is in parallel with claim 13 and rejected for at least the same reasons.

As per claim 14,  
Hartrick et al. ('920) discloses the method of claim 13 wherein the selectively  
downloading step includes:  
comparing the unique key with a key for the viewer; and preventing the downloading if  
the unique key does not match the key for the viewer.(Column 14, lines 39-50)

Claim 24 is in parallel with claim 14 and rejected for at least the same reasons.

As per claim 15,  
Hartrick et al. ('920) discloses the method of claim 10  
wherein the downloading step includes decrypting the text material.(Column 4, lines 53-  
57)

Claim 25 is in parallel with claim 15 and rejected for at least the same reasons.

As per claim 16,  
Hartrick et al. ('920) discloses the method of claim 10  
wherein the downloading step includes decompressing the text material.(Column 4, lines  
53-57)

Claim 26 is in parallel with claim 16 and rejected for at least the same reasons.

As per claim 17,  
Hartrick et al. ('920) discloses the method of claim 10  
further including permitting a user to purchase the electronic books.(Figure 11)

Claim 27 is in parallel with claim 17 and rejected for at least the same reasons.

As per claim 18,  
Hartrick et al. ('920) discloses the method of claim 10  
Official Notice is taken that "limiting access to the text material based upon a time  
parameter" is common and well known in prior art in reference to digital media. It would have  
been obvious to one having ordinary skill in the art at the time the invention was made to limit  
access to the text material based upon a time parameter in order to maximize the potential  
profitability of the media y allowing it to be repurchased in the future.

Art Unit: 3621

Claim 28 is in parallel with claim 18 and rejected for at least the same reasons.

As per claim 19,

Hartrick et al. ('920) discloses the method of claim 10

Official Notice is taken that "limiting access to the text material based upon a number of downloads and viewing of the text material" is common and well known in prior art in reference to digital media. It would have been obvious to one having ordinary skill in the art at the time the invention was made to limit access to the text material based upon a number of downloads and viewing of the text material in order to maximize the potential profitability of the media y allowing it to be repurchased in the future.

Claim 29 is in parallel with claim 19 and rejected for at least the same reasons.

### *Conclusion*

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

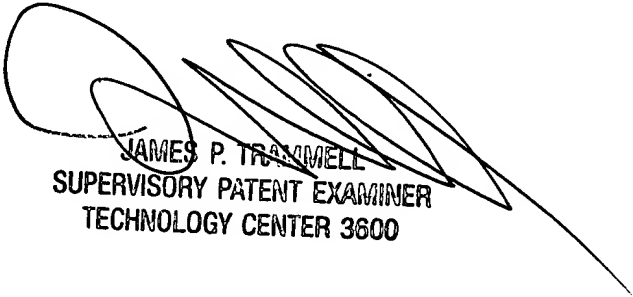
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

June 26, 2004

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600